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#788/13662
PATENT NO.
7284,52829-R



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Application of

David G. Bird

Serial No.: 08/862,039

Filed: May 22, 1997

For: LOCATION OF MISSING
VEHICLES

Reissue of Original Patent
No. 5,418,537 issued May 23, 1995

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Group Art Unit: 3662

Examiner: Blum, T.

Appeal No.: 2002-0393

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William E. Pelton June 10, 2002
William E. Pelton Date
Reg. No. 25,702

APPELLANT'S SUPPLEMENTAL APPEAL BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

By Order dated April 10, 2002, the Board of Patent Appeals and Interferences has required appellant to clarify the record by addressing in a Supplemental Appeal Brief the impact on the rejection before the Board in this appeal of the decision of the Court of Appeals For the Federal Circuit in Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), decided July 25, 2001. In particular, the Board has directed appellant to the last sentence of the

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Pannu decision, which reads as follows: “On reissue, he [patentee] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.”

Summary of Appellant’s Comments On the Pannu Decision

The Pannu decision does not alter, but confirms, the well established recapture analysis, which ultimately requires the Board to determine whether appellant’s reissue claims are in some material respect narrower than previously canceled claims.

Appellant’s Detailed Comments

The statement quoted above from the Pannu decision does not mean that on reissue the patentee cannot, under any circumstances, broaden a claim by eliminating a limitation that had been added during prosecution of the original patent to overcome prior art. The Pannu decision recognizes that under some circumstances, this is permissible. Those circumstances exist when the reissue claim contains one or more material limitations that were not in claims canceled during prosecution of the original patent. In Pannu, the appeals court said that “Application of the recapture rule is a three-step process [the third step of which is] Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.” Pannu, 258 F.3d at 1371. As did appellant in its opening brief, the appeals court cited Hester Industries Inc. v. Stein Inc., 142 F.3d 1472, 1482-83, 46 USPQ 2d 1641, 1649-50 (Fed. Cir. 1998) as support for the proposition that the correct recapture analysis is to inquire whether the reissue claims include a material narrowing limitation not present in claims deliberately canceled during prosecution of the original patent. Pannu, 258 F.3d at 1371. In fact, Pannu lost his appeal only because the Federal Circuit disagreed with Pannu’s argument that his reissue claims were materially narrowed by limitations not present in canceled claims. The appeals court said: “The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and

dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening [emphasis added].” Pannu, 258 F.3d at 1372. Since the reissue claims were not perceived by the appeals court in Pannu to have been narrowed in any material respect, it was held that the recapture rule was not avoided.

The facts here are different from those in Pannu, allowing the Board to reach a different conclusion. Here, each of the reissue claims 28-49, 54-55 and 58-59 (Group B) calls for a paging request responder and a communications device capable of operation independent of the paging request responder, or a method employing such devices (see for example claim 28 as amended and the similar recitations in claims 29-33). None of the claims canceled from the parent application Serial No. 07/978,272 ever contained such a limitation. Similarly, claims 50-53 and 56-57 (Group C) specify a non-cellular paging request responder. No claim canceled from the parent application ever contained such a limitation.

Appellant’s narrowing limitations are material. They add to the claimed structure and its function and are therefore far more material than limitations relating only to “positioning and dimensions,” as was the case in Pannu. Pannu therefore does not support a finding that previously surrendered subject matter is being recaptured in appellant’s application.

The estoppel referred to by the appeals court in the sentence from the Pannu decision quoted by the Board arose because Pannu not only deleted from his reissue claims a limitation originally added to overcome prior art, but also failed, as the appeals court held, to include in his reissue claims material limitations that narrowed his reissue claims in other respects. In contrast, appellant is not estopped because the “independent operation” and “noncellular” limitations added to reissue claims 28-59 not only were not contained in any previously canceled claim, but have materially narrowed

the claims on appeal, and have in fact been found by the Examiner to render the reissue claims patentably distinguishable from the prior art.

Conclusion

The Pannu decision does not mandate a holding that reissue claims 28-59 are invalid for recapture. Pannu requires that the Board make a determination whether the narrowing limitations contained in appellant's reissue claims 28-59 are material. If the Board finds the narrowing limitations to be material, as appellant contends, Pannu does not prohibit, but rather supports a finding by the Board that recapture has been avoided by appellant.

Dated: June 10, 2002

Respectfully submitted,

By 

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